



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2012-0036]

September 15, 2012 Deadline to File Requests for Inter Partes Reexamination Proceedings and Modification of Notice of Failure to Comply Form

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice.

SUMMARY: Pursuant to section 6(c)(3) of the Leahy-Smith America Invents Act (AIA), the authority to file inter partes reexamination requests terminates effective September 16, 2012. Accordingly, any original or corrected/replacement request for an inter partes reexamination submitted on or after September 16, 2012, will not be accorded a filing date, and any such request will not be granted. This notice provides guidance to inter partes reexamination requesters with respect to timely filing requests prior to September 16, 2012, i.e., by the September 15, 2012, last day for filing of an inter partes reexamination request.

FOR FURTHER INFORMATION CONTACT: Kenneth M. Schor, Senior Legal Advisor ((571) 272-7710), or Joseph F. Weiss, Jr., Legal Advisor ((571) 272-7759), Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy.

SUPPLEMENTARY INFORMATION:

A. Filing requests as early as possible

Requesters are advised to file any inter partes reexamination requests which they intend to file as soon as possible, in order to provide the United States Patent and Trademark Office (Office) with maximum time to: (i) receive, process, and review such requests for their compliance with all the filing date requirements for inter partes reexamination; and (ii) notify the requester of any deficiencies in the request via a Notice of Failure to Comply with Inter Partes Reexamination Request Filing Requirements (Notice of Failure to Comply) while providing sufficient time for requester to submit a corrected/replacement request prior to September 16, 2012.

In this regard, it is to be noted that any inter partes reexamination request must meet all the filing date requirements for inter partes reexamination, i.e., it must be filing-date compliant, prior to September 16, 2012. If a timely filed inter partes reexamination request fails to meet any filing date requirement for inter partes reexamination, then the

requester will be so notified and, if time allows, given an opportunity to complete the request by filing a corrected/replacement request by September 15, 2012. If the request papers are then made filing-date compliant by a response which is properly filed with the Office by September 15, 2012, the filing date of the response will be assigned to the request (this is also true for any sua sponte filed corrected/replacement request). If the corrected/replacement request is not received by the Office as of September 15, 2012, the corrected/replacement request will not be accorded a filing date, even though the original request was timely received by the Office. This is so, regardless of when requester receives notification that the original request is not filing-date compliant.

The Office will make every effort to promptly and efficiently process and review all requests for inter partes reexamination. It is to be emphasized, however, that the Office cannot guarantee that a Notice of Failure to Comply with Inter Partes Reexamination Request Filing Requirements will be issued by the Office prior to September 16, 2012, or even if it is so issued, that sufficient time will remain for the mailing to reach a requester and allow for response prior to September 16, 2012. While, traditionally, the Office has been setting a thirty-day period to respond to the Notice of Failure to Comply, this will no longer be possible for any Notice of Failure to Comply mailed after August 16, 2012, because the statute which provides for the filing of a request for inter partes reexamination will no longer be in effect as of September 16, 2012.

In view of the above, potential inter partes reexamination requesters are cautioned to file any such requests as soon as possible, in order to provide the Office with as much time as

possible to receive the requests, process and review them, and notify requester with sufficient time to correct the request, if necessary, prior to September 16, 2012.

B. The last day to file an inter partes reexamination request

As mentioned above, section 6(c)(3) of the AIA statutorily terminates the authority for inter partes reexamination filings effective September 16, 2012. Since, inter partes reexamination filing is not available on or after September 16, 2012, the Office cannot grant a filing date to any inter partes reexamination request filed after September 15, 2012. In addition, as the termination of authority for inter partes reexamination filings in section 6(c)(3) of the AIA is not a time period for taking action under 35 U.S.C. 21(b), the provisions of 35 U.S.C. 21(b) do not authorize the Office to accept or accord a filing date to an original or corrected/replacement request for inter partes reexamination which is filed on or after September 16, 2012, even though September 15, 2012, the last day to file a request, is a Saturday.

An inter partes reexamination request can be submitted on Saturday, September 15, 2012, but only two methods are available to do so. The request may be submitted that Saturday: (1) via the Office's Web-based electronic filing system, EFS-Web (see MPEP 502.05); or (2) by using the 37 CFR 1.10 "Express Mail" mailing procedure (see MPEP 513). No other method of submission is available for a Saturday. Thus, a request cannot be submitted on September 15, 2012, by hand, by courier, by facsimile transmission, or by mail other than Express Mail. If an attempt to do so is made, the request will not be

received by the Office (on that Saturday), and a filing date will not be accorded to the request.

If an original or corrected/replacement inter partes reexamination request is mailed (by mail other than Express Mail), the requester should take into consideration mailing time and the fact that 37 CFR 1.8 certificate of mailing and transmission procedures are not available for filing an original or corrected/replacement request for reexamination (see MPEP 2624). Thus, requester should take care to mail the request sufficiently early for the Office to receive it by Friday, September 14, 2012 (the Office does not receive mail on Saturday, the 15th – see 37 CFR 1.6(a)(1)).

C. Modification of Notice of Failure to Comply Form

In view of the above:

1. Any Notice of Failure to Comply mailed prior to September 15, 2012, will reference September 15, 2012, as the due date for any corrected/replacement inter partes reexamination request.

2. Any Notice of Failure to Comply mailed on or after September 17, 2012, will not set a period for response, but will rather inform requester that no filing date can be granted for the request, because inter partes reexamination filing has been statutorily terminated.

Date: August 23, 2012

Teresa Stanek Rea
Deputy Under Secretary of Commerce for
Intellectual Property and Deputy Director of the
United States Patent and Trademark Office

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